

## **REMARKS**

### **Amendments**

New claims 31-35 are directed to further aspects of applicants' invention. See, e.g., the disclosure bridging pages 7-8.

### **Rejection Under 35 U.S.C. §103 In View of Claverly et al. (US 5,401,731)**

Claims 1-3, 5, 6, 8-11, and 14-30 are rejected as allegedly being obvious under 35 USC §103 in view of Claverly et al. (US '731). This rejection is respectfully traversed.

US '731 discloses a genus of vitamin D analogues which have a side chain ending with the group  $-CR^1R^2-OH$  wherein  $R^1$  and  $R^2$  can each be hydrogen or  $C_{1-8}$ -hydrocarbyl. Suitable  $C_{1-8}$ -hydrocarbyl groups disclosed in US '731 are methyl, trifluoromethyl, ethyl, vinyl, n-propyl, iso-propyl, cyclopropyl, and 1-methylvinyl. See, e.g., column 1, lines 20-59.

This genus does not encompass compounds of applicants' claimed invention. Compare the terminal OH group of the side chain of US '731 with applicants' group Z which is defined in independent claims 1 and 30 as an optionally substituted hydrocarbon radical. See also claims 2, 3, 26, 28, and 31-35 all of which further define group Z. Thus, contrary to the rejection, the genus of US '731 does not embrace applicants' claimed invention.

The rejection then asserts that it would be obvious to select any species of the genus disclosed in the prior art reference. Even if this assertion were correct (which it is not), this would not lead one to a compound of applicants' claimed invention. In any event, the asserted conclusion is not supported by any rationale. The rejection fails to establish why one would select any particular compound of the prior art genus. Moreover, the rejection fails to present any reasoning as to why one would modify any compound of the prior art genus so as to arrive at a compound of the claimed invention.

The rejection asserts that a prior art genus of compounds is sufficient, by itself, to render obvious all species falling within that genus. This assertion is simply contrary to well settled law. In support of this improper assertion, the rejection cites *Merck v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (Fed. Cir. 1989). But, *Merck* did not deal with a genus of compounds. It dealt with a prior art disclosure of a composition comprising two components. The two components of the claimed composition were both disclosed in the prior art reference.

In the instant case, the prior art genus encompasses a vast number of compounds and the rejection fails to demonstrate how the prior art leads one to a compound of the claimed invention. See, e.g., the non-precedential decision, *Ex parte Rozzi*, 63 USPQ2d 1196 (POBA 2002), where the Board in vacating a §103 rejection stated that:

The examiner does not make out a case of obviousness merely by virtue of the fact that the subject matter of a rejected claim is, to use the examiner's words, "generically" described by the prior art. *Cf. In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound).

One of ordinary skill in the art presented with the disclosure of US '731 and its broad genus of compound is not provided with sufficient motivation to modify the compounds disclosed therein in such a manner as to arrive at a compound in accordance with applicants' claims genus. The mere disclosure of a broad genus of compounds does not, in and of itself, even establish obviousness with respect to each and every compound encompassed therein. See, for example, *In re Jones*, 21 USPQ 2d 1941 (Fed. Cir. 1991) and *In re Baird*, 29 USPQ 2d 1550 (Fed. Cir. 1994). Instead, the disclosure must provide some motivation which would lead one of ordinary skill in the art, without the benefit of hindsight, to modify the disclosed compounds in such a manner as to arrive at the claimed compound.

In this case, no such motivation is presented in US '731 or is asserted in the rejection that would lead one of ordinary skill in the art to modify the compounds disclosed therein in such a manner as to arrive at another specific compound within that disclosed genus, let alone a compound in accordance with applicants' claimed genus. Merely asserting that a reference has a generic disclosure which overlaps a claim does not satisfy the requisite showing of motivation for obviousness as discussed by the Court in *Jones* and *Baird*, especially when the underlying premise of an overlap is incorrect.

In view of the above remarks, it is respectfully submitted that US '731 fails to provide sufficient motivation to render obvious applicants' claimed invention. Withdrawal the rejection under 35 U.S.C. §103 is respectfully requested.

Respectfully submitted,



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Brian P. Heaney (Reg. No. 32,542)

Attorney for Applicant(s)

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.

Arlington Courthouse Plaza I, Suite 1400

2200 Clarendon Boulevard

Arlington, Virginia 22201

(703) 812-5308 [Direct Dial]

(703) 243-6410 [Facsimile]

Internet Address: [heaney@mwzb.com](mailto:heaney@mwzb.com)

Filed: May 23, 2003